

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q65593

Hubert HELAINE, et al.

Appln. No.: 09/918,501

Group Art Unit: 2617

Confirmation No.: 3234

Examiner: Morcos L. TORRES

Filed: August 1, 2001

For: AUTOMATIC METHOD OF MANAGING NETWORK SERVICES

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief.

The statutory fee of \$510.00 is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/ Andrew J. Taska /

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Andrew J. Taska
Registration No. 54,666

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 15, 2008

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q65593

Hubert HELAINE, et al.

Appln. No.: 09/918,501

Group Art Unit: 2617

Confirmation No.: 3234

Examiner: Morcos L. TORRES

Filed: August 1, 2001

For: AUTOMATIC METHOD OF MANAGING NETWORK SERVICES

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST	2
II. RELATED APPEALS AND INTERFERENCES	3
III. STATUS OF CLAIMS	4
IV. STATUS OF AMENDMENTS	5
V. SUMMARY OF THE CLAIMED SUBJECT MATTER	6
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	13
VII. ARGUMENT	14
VIII. CONCLUSION	28
CLAIMS APPENDIX	29
EVIDENCE APPENDIX	33
RELATED PROCEEDINGS APPENDIX	34

I. REAL PARTY IN INTEREST

The real party of interest is Alcatel, of Paris, France, by virtue of an assignment executed by Hubert Helaine on July 15, 2001 and France Dervaux on July 13, 2001. The assignment was recorded on August 1, 2001, at Reel 012051, Frame 0775.

II. RELATED APPEALS AND INTERFERENCES

To the best of the knowledge and belief of Appellant, Appellant's legal representatives, and the assignee in this application, there are no other pending appeals or interferences before the Board of Appeals and Interferences (hereinafter "the Board") that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-16 are all of the claims currently pending in the present application. Currently, claims 1-16 stand rejected by the Examiner, and are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

A Response under 37 C.F.R. § 1.116 was filed on September 12, 2007, in response to the Office Action dated July 16, 2007. There are no outstanding, non-entered amendments of the claims.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a method for automatically managing network services. More particularly, Appellant's invention relates to a method for enabling a user who subscribes to a mobile telephone service and to a landline telephone service to access the associated services (e.g., call forwarding, voicemail, etc.) in a totally transparent manner such that the user can access the terrestrial network or the mobile network from the same handset or terminal in exactly the same way. As a result, the user does not have to memorize and use multiple different sets of service codes for specific use with the mobile telephone service and the landline telephone service, respectively.

As a matter of example to more fully explain the invention, Appellant will describe the features shown in the exemplary embodiments of the invention, which are described in detail on pages 4-12 of the Specification. Portions of the claims that correspond to the features shown in the exemplary embodiments are also referenced during this discussion. However, this discussion of the exemplary embodiments and the pending claims is provided for explanatory purposes only, and is not intended to limit the scope of the claims in any way.

Conventional terrestrial telephone networks and mobile telephone networks offer a variety of different services to users. Such services may include, for instance, call forwarding, call barring, voicemail, etc., and can be accessed using a terminal connected to the respective network. And, such services can be accessed, for example, by pressing a sequence of keys on the keypad of a terminal, or by entering an access code.

While many terrestrial telephone networks and mobile telephone networks offer different services to users, the services offered are not necessarily identical, and even if the offered services are identical, the services are not necessarily accessed in the same manner.

Accordingly, a user of a terrestrial telephone network must know the procedures for accessing the terrestrial network services and the procedures or access codes for accessing the mobile telephone network services.

Generally speaking, access procedures consist of typing in numerical codes which are not easy to memorize. Not to mention that, in order to utilize both a terrestrial telephone network and a mobile telephone network, users must purchase two different terminals, a terrestrial telephone network terminal and a mobile telephone network terminal.

Conventional terminals have been developed which enable a user to make calls via both a terrestrial telephone network and a mobile telephone network, which constitutes an alternative to purchasing two different terminals. However, such terminals are expensive because they consist of a combination of a terrestrial telephone network terminal and a mobile telephone network terminal, which are in the same housing. Furthermore, such conventional terminals do not do away with the need for a user to memorize the procedures for accessing the services offered by the terrestrial telephone network and for accessing the services offered by the mobile telephone network, respectively.

One illustrative and non-limiting embodiment of the present invention addresses the above problems by connecting a mobile telephone to a private base that is itself connected to the network of a terrestrial telephone operator, for example, to a public switched telephone network.

According to this exemplary embodiment, the mobile telephone and the private base are connected in a manner that is specific to the mobile telephone.

By way of illustration, in one selected mode of operation, the mobile telephone automatically connects to the private base that belongs to a terrestrial telephone network as soon as the mobile telephone is within range of the private base. On the other hand, when the mobile telephone is no longer within range of the private base, the mobile telephone automatically disconnects from the private base and reconnects to the mobile telephone network immediately. Moreover, when the mobile telephone is connected to the private base, the mobile telephone behaves like an access terminal to the terrestrial telephone network.

Therefore, according to an exemplary embodiment of the present invention, a user of the mobile telephone who wants to access services of either the mobile telephone network or the terrestrial telephone network can do so using the same interface, namely, the mobile telephone. In particular, if a user requests access services and the mobile telephone is connected to the private base at the time, then the mobile telephone sends the service request to the private base. The private base, in turn, converts the service request into a format of the terrestrial telephone network and then transmits the converted request to the terrestrial telephone network operator. According to one exemplary embodiment, this change in format is effected by means of a memory, which may store, for instance, a conversion table.

A central issue on this appeal involves the distinction between a private base and a public base station of a mobile telephone network. A person of ordinary skill in the art would readily discern that a private base is just that—a base which is configured for the private use of a respective terminal or terminals.

As made clear in the present specification, a private base is completely different than a base station of a public mobile telephone network, which is configured for use by the general public. (*See e.g.*, page 5, lines 1-3). Indeed, the specification describes that a private base and a base station of a public mobile telephone network are completely different devices, with completely different structures and different functions.

For instance, the present specification describes that the range of a private base is generally restricted compared to the range of a base station of a public mobile telephone network. Further, the specification describes an exemplary embodiment of the present invention wherein the range of a private base 102 is restricted to a few hundred meters and, as a result, is not picked up by the base stations of a public mobile telephone network. (Page 5, lines 1-3). In contrast, the range of a base station of a public mobile telephone network provides a much wider coverage area relative to private bases, so as to facilitate access to the public in a cell which may extend over several miles.

In short, private bases are configured in an entirely different manner than public base stations of mobile telephone networks and private bases perform fundamentally different operations than public base stations. Put simply, whereas private bases are configured for private use by an individual, public base stations of mobile telephone networks are configured for public use by the public at large.

A. Identification of Independent Claims

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language of independent claims 1, 15 and 16 below:

1.(previously presented): An automatic network services management method comprising:

connecting a communication terminal of a first network to a private base;

connecting said private base to a second network; and

a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.

15.(previously presented): A communication terminal, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

16.(previously presented): A private base, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

B. Mapping of Generally Expressed Claim Language of Independent Claims to Specification by Page and Line Number

Claim 1:

An automatic network services management method is provided. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). The method comprises connecting a communication terminal of a first network to a private base. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). The method further comprises connecting said private base to a second network. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30; Figures 1-2). The method also comprises a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

Claim 15:

A communication terminal, adapted to implement an automatic network services management method is provided. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). A communication terminal of a first network is also provided. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). Moreover, a private base is provided which is connected to a second network, wherein said communication terminal is connected to said private base. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30; Figures 1-2). A memory is also provided which is structured to establish a correspondence

between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

Claim 16:

A private base is provided which is adapted to implement an automatic network services management method. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). Also provided is a communication terminal of a first network. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). A private base is provided which connected to a second network, wherein said communication terminal is connected to said private base. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30; Figures 1-2). Additionally, a memory is provided which is structured to establish a correspondence between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Whether or not claims 1-2, 9 and 12-16 are unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,035,193 to Buhrmann (hereinafter “Buhrmann”), and in view of U.S. Patent No. 6,029,065 to Shah *et al.* (hereinafter “Shah”).
- (2) Whether or not claim 3 is unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”).
- (3) Whether or not claims 4 and 6-7 are unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”).
- (4) Whether or not claim 5 is unpatentable under 35 U.S.C. § 103(a) in view Buhrmann, in view of Shah, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter “Heuvel”).
- (5) Whether or not claims 8-11 are unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, and further in view of Kasmperschroer.

VII. ARGUMENT

A. Claim Rejections under 35 U.S.C. §103 – Buhrmann in view of Shah

As discussed above, the Examiner has rejected claims 1-2, 9 and 12-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,035,193 to Buhrmann (hereinafter “Buhrmann”), and in view of U.S. Patent No. 6,029,065 to Shah *et al.* (hereinafter “Shah”).

1. Independent Claim 1

Buhrmann teaches the feature of a wireless radio telephone that is operative with a landline supported private base station that can switch into communication with a cellular network. Column 1, lines 6-9. That is, Buhrmann merely teaches what is already disclosed in the present specification at page 3, lines 2-8.¹ And, as explained in the present specification, terminals like those taught in Buhrmann do not do away with the tedious need for the user to become familiar with the procedures for accessing the services offered by the landline supported network and the procedures for accessing the services offered by mobile telephone network, respectively.

To address such disadvantages of conventional devices, and other disadvantages, independent claim 1 recites the features of (among other things):

...connecting a communication terminal of a
first network to a private base;

connecting said private base to a second
network; and

a correspondence memory establishing a
correspondence between service codes of said

¹ “Also known in the art are terminals able to make calls via a mobile telephone network and via a terrestrial telephone network.”

first network and service codes of said second network.

That is, claim 1 plainly requires the features of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base.

The grounds of rejection acknowledge that Buhrmann fails to teach or suggest the feature of a correspondence memory, as claimed. Nevertheless, the grounds of rejection apply Shah, alleging that Shah discloses a memory establishing correspondence. Further, the grounds of rejection allege that it would have been obvious to one of ordinary skill in the art to modify the teachings of Buhrmann with the teachings of Shah, so as to arrive at the claimed invention, for the simple purpose of compatibility between networks, as allegedly taught by Shah. Appellant respectfully disagrees with the grounds of rejection for *at least three* fundamental reasons, which are explained in detail below.

First, the grounds of rejection have failed to establish even a *prima facie* case of obviousness because they have failed to demonstrate that either Buhrmann, Shah, or any combination thereof, teaches or suggests the feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base, as claimed. The grounds of rejection admit that Buhrmann fails to teach or suggest these features. 02/02/07 Office Action, page 3. In fact, Buhrmann teaches just the opposite of establishing a correspondence between service codes of two networks, as claimed, in that Buhrmann expressly

teaches that the mobile operator must memorize and use the service codes that are specific to Buhrmann's private base station. *See* column 7, line 57 – column 8, line 10.

Moreover, Shah does not remedy the deficient teachings of Buhrmann. Contrary to the recitations of claim 1, Shah teaches that a local base station of a public mobile telephone network determines what features a visiting mobile telephone of a public user supports, and then provides the feature codes to the visiting mobile telephone that are required to access the network features. (*See e.g.*, Abstract). That is, Shah teaches a method for remote feature code programming and conversion for a visiting mobile station of a public user (i.e., a mobile station of a user from the public at large), which is accessing a public base station, rather than accessing the mobile station's home network. Column 3, lines 25-53.

Hence, at the very most, Shah teaches conversion between feature codes of two public base stations. But, importantly, Shah does not provide any teaching or suggestion whatsoever regarding a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base, as claimed. In fact, Shah teaches just the opposite in that Shah expressly teaches only feature code conversion between two public base stations.

Moreover, the public base stations taught in Shah are fundamentally different than the private base recited in claim 1. A few of many such fundamental differences include, but are not limited to, differences in coverage area, configuration, structure, operating methods, transmitting/receiving frequencies, security, access methods, privacy, number of users, etc. For example, public base stations are configured to provide an extremely wide coverage area so as to facilitate access to the general public in a cell, which may extend over several miles. In contrast,

a private base is restricted to a comparatively tiny coverage area of just a few hundred meters, and is configured for private use by an individual. See e.g., page 5, lines 1-3 of the present specification. Therefore, public base stations, like those taught in Shah, exhibit numerous fundamental differences from a private base, as claimed. As such, Shah fails to teach or suggest all of the claimed features for *at least* these reasons.

In response to Appellant's previous arguments to this effect, the grounds of rejection allege that Appellant's comment that public base stations are configured to a wide coverage area is misplaced, since "base station[s] come in all flavors with low, medium, or high power." For instance, the grounds of rejection allege that base stations with low power are well known in the art as a micro cell or a Pico cell. However, even assuming *arguendo* that the Examiner's allegations that "base station[s] come in all flavors with low, medium, or high power,"² were true, Shah provides no teaching or suggestion whatsoever that the public base station described therein is a micro cell or a Pico cell of the sort referenced by the grounds of rejection.

And, even if Shah were to teach that the base station therein *were* a micro cell³, as proposed in the grounds of rejection, such a public micro cell base station would still be

² The grounds of rejection do not provide any evidentiary basis for the assertion that "base station[s] come in all flavors with low, medium, or high power." Indeed, the Examiner has not pointed to any aspect of the cited references that supports this assertion², nor has the Examiner provided, any prior reference to show that the above aspects of the present invention are capable of instant and unquestionable demonstration as being "well-known", as required by MPEP § 2144.03. To the contrary, the grounds of rejection rely on citations to www.wikipedia.org, without providing any evidence to demonstrate that such citations are reliable, or that such citations actually constitute prior art to the claimed invention.

³ Appellant submits that Shah provides no teaching or suggestion that the public base station therein is a micro cell or a Pico cell.

fundamentally different than the private base, as claimed. For instance, such a purported public micro cell base station would still provide an extremely wide coverage area compared to the claimed private base. However, the grounds of rejection do not identify any aspect of the cited references that correspond to the specific claimed combination including a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base.

Secondly, rather than identifying the specific portions of either Burhmann or Shah that teach or suggest the claimed correspondence memory, the grounds of rejection simply allege that it would have been obvious to combine the teachings of Burhmann and Shah and that such a combination would achieve the claimed invention.

Again, Appellant respectfully disagrees. Even if one were to combine the teachings of Buhrmann with those of Shah, as proposed by the grounds of rejection, one still would not arrive at the specific recitations in claim 1. Quite to the contrary, if one were to modify Buhrmann's wireless radio telephone, which is operative with a landline supported private base station, with Shah's teaching of conversion between feature codes of two public base stations, the result would be completely different from claim 1. In stark contrast to claim 1, a combination of Buhrmann and Shah would yield a wireless radio telephone, which is operative with a landline supported private base station (as taught in Buhrmann), wherein, if the wireless radio telephone visits a public base station of a public mobile telephone network (that is other than its home public base station), then the visited public base station determines what features the visiting

wireless radio telephone supports and provides the feature codes that are required to access the visited network features (as taught in Shah).

Therefore, the proposed combination of Buhrmann and Shah still fails to achieve the claimed invention of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base. And, a skilled artisan would have to further modify the proposed combination of Buhrmann and Shah (which teaches nothing more than conversion of feature codes between two public base stations) to arrive at the specific combination recited in claim 1. However, the grounds of rejection have failed provide the requisite evidence in fact and/or reasoning as to why a skilled artisan would have made such a further modification to the combination of Buhrmann and Shah. And, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness.⁴ The Examiner has not met this burden with the outstanding grounds of rejection and the grounds of rejection fail for *at least* these reasons.

Indeed, the Examiner cannot possibly meet this requisite burden because there is no teaching or suggestion whatsoever in either Buhrmann or Shah that would lead one of ordinary skill in the art to fundamentally modify the combined teachings of Buhrmann and Shah so as to develop a correspondence memory that establishes a correspondence between service codes of Buhrmann's wireless radio telephone's network (i.e., the alleged first network) and service codes of the landline network of Buhrmann's private base station (i.e. the alleged second network).

⁴ *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Shah teaches conversion between feature codes of two public base stations for mobile stations, but provides no indication whatsoever that such teachings could be successfully applied to the fundamentally different configuration of Buhrmann's private base station, much less that such teachings could be implemented between the network of a wireless radio telephone and the landline network of a private base. Indeed, Shah's teachings are limited only to mobile stations and have nothing at all to do with landline networks. However, the grounds of rejection have failed to identify any teaching or suggestion in the cited references to modify the express teachings of Shah, regarding conversion between feature codes of two public base stations, to achieve the recitations of claim 1. Further, Appellant submits that such a fundamental change would not have been obvious, as a matter of law, since such a proposed modification of Shah would change the principle of operation of the prior art invention being modified (i.e., Shah).⁵

Contrary to the requirements of MPEP §707.07(f), the grounds of rejection fail to provide any substantive response to Appellant's arguments in this regard⁶. In contrast, the 10/17/07 Advisory Action simply reiterates the arguments advanced in the 07/16/07 Office Action without substantively responding to Appellant's arguments. 10/17/07 Advisory Action, page 2. Specifically, the grounds of rejection allege that "Shah discloses using a correspondence memory, so the user does not have to learn the service codes when he moves from one base

⁵ If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01

⁶ MPEP §707.07(f) requires that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" (emphasis added).

station to another type of base station.” 07/16/07 Office Action, page 2. However, these allegations are unsupported by Shah since Shah fails to disclose or suggest using a correspondence memory for enabling a user to move from one base station to another type of base station, as alleged. Quite to the contrary, Shah teaches nothing more than conversion between feature codes of two public base stations (i.e., Shah teaches moving from a home network to a visited network between two base stations of the same type, namely, of the public type). Shah does not provide any teaching or suggestion whatsoever between conversion between feature codes of base stations of different types, much less conversion between feature codes of a public base and a private base.

In response to Appellant’s previous arguments to this effect, the grounds of rejection allege that Appellant fails to mention how the fundamental differences between private base stations and public base stations affect feature codes. 07/16/07 Office Action, Page 2. Appellant respectfully disagrees with this allegation and submits that such an allegation is misplaced and diverges from the requirements of 35 U.S.C. § 103. To properly maintain a rejection under 35 U.S.C. § 103, the Examiner must establish that Buhrmann, Shah, or some combination thereof, teaches or suggests the feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed, and this is the focus of the obviousness inquiry. The Examiner’s allegations that Appellant has failed to mention how the fundamental differences between public and private base stations affect feature codes do not substantively respond to Appellant’s arguments that both Buhrmann, Shah, and any combination thereof, fail to teach or suggest a correspondence memory establishing a correspondence between service

codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed.⁷

Moreover, even assuming *arguendo* that the allegations in the grounds of rejection *were* true, that covering a wide area does not affect feature codes⁸, Shah nevertheless fails to teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed. Accordingly, the current rejections are improper regardless of how the fundamental differences between private base stations and public base stations affect feature codes.

Third, the grounds of rejection also fail because one of ordinary skill in the art would not have been motivated to combine the teachings of Buhrmann and Shah in the manner proposed. The grounds of rejection allege that a skilled artisan would have been motivated to combine the teachings of Buhrmann and Shah to arrive at the claimed invention for the simple purpose of compatibility between networks, as allegedly taught by column 1, lines 5-10 of Shah.

Appellant respectfully disagrees since Shah does not support the alleged motivation for which it is cited. Shah teaches that it is desirable to provide a user-transparent conversion of network feature codes in a mobile station to facilitate the mobile station's access to a visited public mobile telephone network. Therefore, if anything, a skilled artisan would look toward

⁷ Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. MPEP §707.07(f).

⁸ Appellant firmly submits that the allegations in the grounds of rejection that covering a wide area does not affect feature codes are unsupported and without evidentiary basis.

Shah for teachings regarding how to convert feature codes in a mobile station as the mobile station switches to a visited public mobile telephone network. However, Shah does not provide any motivation for a skilled artisan to establish a correspondence between service codes of Buhrmann's public wireless radio telephone's network and service codes of the landline network of Buhrmann's private base station, as suggested by the grounds of rejection.

In response to Appellant's arguments in this regard, the grounds of rejection allege that both Buhrmann and Shah are directed to providing services between networks using service codes and, as such, the references are analogous and properly combinable with totally predictable results since the service codes are not affected if the base station is public or private.

Appellant vigorously disagrees. The mere allegation that both Buhrmann and Shah relate to service codes, without more, still fails to identify any motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.² Therefore, the grounds of rejection still fail to point to any specific motivation for a skilled artisan to establish a correspondence between service codes of Buhrmann's public wireless radio telephone's network and service codes of the landline network of Buhrmann's private base station.

Moreover, Buhrmann and Shah are not combinable with claim 1 being a totally predictable result of such a combination, as alleged. To the contrary, Shah's public base stations are fundamentally different than the private base station taught in Buhrmann and, therefore, the feature of a correspondence memory establishing a correspondence between service codes of a

² *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

first network of a communication terminal, and service codes of a second network, which is connected to a private base, would not have been totally predictable from these references. In contrast, the claimed invention addresses a long-felt but unresolved need of providing a user access to the services of both a terrestrial network and the mobile network from the same handset in exactly the same way, without having to memorize the service codes for each network, respectively.

Accordingly, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 1 for *at least* these reasons. Further, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claims 2, 9 and 12-14, *at least* by virtue of their dependency on claim 1.

2. Independent Claim 15

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to independent claim 1, Appellant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited references *at least* for reasons analogous to those presented above. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 15 for *at least* these reasons.

3. Independent Claim 16

In view of the similarity between the recitations of claim 16 and the recitations discussed above with respect to independent claim 1, Appellant respectfully submits that the foregoing

arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited references *at least* for reasons analogous to those presented above. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 16 for *at least* these reasons.

B. Claim Rejections under 35 U.S.C. § 103 – Buhrmann in view of Shah and further in view of Sipilä

The Examiner has rejected claim 3 as allegedly being unpatentable over Buhrmann, in view of Shah, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter "Sipilä"). Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 3 for *at least* the independent reasons stated below.

Claim 3 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, neither Buhrmann, Shah, nor any combination thereof, teaches or suggests all the recitations of claim 1. Moreover, Sipilä also fails to remedy the deficient teachings of Buhrmann and Shah. Therefore, Appellant respectfully submits that claim 3 is patentable over Buhrmann, Shah, Sipilä, and any combination thereof, *at least* by virtue of its dependency on claim 1. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejection of claim 3.

C. Claim Rejections under 35 U.S.C. § 103 – Buhrmann, in view of Shah, in view of Sipilä, and further in view of Kasmperschroer

The Examiner has rejected claims 4 and 6-7 as allegedly being unpatentable over Buhrmann, in view of Shah, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter "Kasmperschroer"). Appellant respectfully requests that the

Board overturn the Examiner's rejections with respect to claims 4 and 6-7 for *at least* the independent reasons stated below.

Claims 4 and 6-7 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, neither Buhrmann, Shah, nor any combination thereof, teaches or suggests all the recitations of claim 1. Further, both Sipilä and Kasmperschroer fail to remedy the deficient teachings of Buhrmann and Shah. Hence, Appellant respectfully submits that claims 4 and 6-7 are patentable over Buhrmann, Shah, Sipilä, Kasmperschroer, and any combination thereof, *at least* by virtue of their dependency on claim 1. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections of claims 4 and 6-7.

D. Claim Rejections under 35 U.S.C. § 103 – Buhrmann, in view of Shah, in view of Sipilä, in view of Kasmperschroer, and further in view of Heuvel

The Examiner has rejected claim 5 as allegedly being unpatentable over Buhrmann, in view of Shah, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter "Heuvel"). Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 5 for *at least* the independent reasons stated below.

Claim 5 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, neither Buhrmann, Shah, nor any combination thereof, teaches or suggests all the recitations of claim 1. Moreover, Sipilä, Kasmperschroer, and Heuvel all fail to remedy the deficient teachings of Buhrmann and Shah. Therefore, Appellant respectfully submits that claim 5 is patentable over Buhrmann, Shah, Sipilä, Kasmperschroer, Heuvel and any combination

thereof, *at least* by virtue of its dependency on claim 1. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejection of claim 5.

E. Claim Rejections under 35 U.S.C. § 103 – Buhrmann, in view of Shah, and further in view of Kasmperschroer

The Examiner has rejected claims 8-11 as being unpatentable over Buhrmann, in view of Shah, and further in view of Kasmperschroer. Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claims 8-11 for *at least* the independent reasons stated below.

Claims 8-11 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, neither Buhrmann, Shah, nor any combination thereof, teaches or suggests all the recitations of claim 1. Moreover, Kasmperschroer fails to remedy the deficient teachings of Buhrmann and Shah. Therefore, Appellant respectfully submits that claims 8-11 are patentable over Buhrmann, Shah, Kasmperschroer, and any combination thereof, *at least* by virtue of their dependency on claim 1. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections of claims 8-11.

VIII. CONCLUSION

In view of the foregoing differences between appealed claims 1-16 and Buhrmann, Shah, Sipilä, Kasmperschroer and Heuvel, Appellant respectfully submits that the appealed claims are patentable over Buhrmann, Shah, Sipilä, Kasmperschroer and Heuvel and any combination thereof.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/ Andrew J. Taska /

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 15, 2008

Andrew J. Taska
Registration No. 54,666

CLAIMS APPENDIX

CLAIMS 1-16 ON APPEAL:

1. An automatic network services management method comprising:
connecting a communication terminal of a first network to a private base;
connecting said private base to a second network; and
a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.
2. The method claimed in claim 1 wherein said correspondence memory is in said communication terminal.
3. The method claimed in claim 1 wherein said correspondence memory is in said private base.
4. The method claimed in claim 3 further comprising:
composing a request corresponding to a service from said communication terminal;
sending said request from said communication terminal and receiving said request at said private base;
updating said request in said private base as a function of said correspondence memory;
and

sending said request to said second network and receiving said request by an operator managing said services of said second network.

5. The method claimed in claim 4 wherein, if said correspondence memory contains no match to said request sent by said communication terminal, said request is transmitted without formatting to an operator managing said services of said second network.

6. The method claimed in claim 4 further comprising receiving an acknowledgement at said communication terminal after processing of said request by an operator managing said services of said second network.

7. The method claimed in claim 4 further comprising receiving an acknowledgement at said private base after processing of said request by an operator managing said services of said second network.

8. The method claimed in claim 1 wherein said correspondence memory is updated during a call between said private base and an operator of said second network.

9. The method claimed in claim 1 wherein said correspondence memory is updated during a call between said communication terminal and an operator of said first network.

10. The method claimed in claim 8 wherein said correspondence memory is updated automatically and periodically.

11. The method claimed in claim 8 wherein said updating is triggered by a user.

12. The method claimed in claim 1 wherein said first network is a mobile telephone network.

13. The method claimed in claim 1 wherein said second network is a terrestrial telephone network.

14. The method claimed in claim 1 wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base.

15. A communication terminal, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

16. A private base, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

EVIDENCE APPENDIX

This Appendix is not applicable to this Appeal.

RELATED PROCEEDINGS APPENDIX

This Appendix is not applicable to this Appeal.